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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/648,578 | 08/25/2003 | James Edwin Funk | 60081-0011 | 4091 |
| 29989 | 7590 | 08/25/2004 | EXAMINER | |
| HICKMAN PALERMO TRUONG & BECKER, LLP 1600 WILLOW STREET SAN JOSE, CA 95125 | | | MEREK, JOSEPH C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3727 | |
| DATE MAILED: 08/25/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/648,578 | Applicant(s) FUNK, JAMES EDWIN | |
| | Examiner Joseph C. Merek | Art Unit 3727 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/24/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6-13 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The substitute abstract has been corrected for length but contains the word comprises. The substitute abstract of the disclosure is objected to because it uses the word comprises. This is a legal term that often used in claims. See above. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Alfero-Kuronya. Regarding claim 1, see Figs. 1-4, where the bag is inside the sheath 30. 18 are the spaced magnets. One is near the distal end of the sheath and one is near the proximal end of the sheath. Regarding claim 8, the magnet housing is item 16 in Fig. 16. Regarding claim 10, the magnet housing is plastic. The method step does not add any structure that is not in the reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8, 9, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa (US 5,367,278) in view of Anderson et al (US 5,871,114). Regarding claim 1, Yoshikawa teaches a non-conductive outer sheath with spaced apart magnets but does not teach the removable inner liner bag configured to container debris. Anderson et al teaches a similar device with a removable bag liner. It would have been removable bag liner of Anderson et al

in the device of Yoshikawa to eliminate or reduce the spillage from the recycled containers. Regarding claim 8, see Figs. 1, 2, and 4 of Yoshikawa where the magnet housing is shown as item 2. Regarding claim 9, see Fig. 5, where 5 is the magnetic shield. Regarding claim 10, the housing is plastic. The method steps do not require any structure that is not in the combination of references. Regarding claim 11, Yoshikawa does not teach the outer sheath being tapered. Anderson et al teach that the outer structure is tapered. It would have been obvious to employ the taper of Anderson et al in the device of Yoshikawa to reduce the shipping volume of multiple containers. Regarding claim 12, official notice is taken that it is well known to make baskets or containers of leather. It would have been obvious to employ leather in basket of Yoshikawa to provide a more visually pleasing container.

Claims 1, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton (US 6,179,025). Regarding claim 1, Sutton as seen in Figs. 1, 3, and 8, teaches an outer sheath with magnets to secure a removable inner bag where the inner bag can be different sizes but does not teach magnets in the same sheath being near the open and closed ends as they are shown in different embodiments. It would have been obvious to employ magnets near both ends to provide a sheath capable of holding different sized bags to reduce the number of sheaths. Regarding claim 12, the outer sheath is made of leather. Regarding claim 13, the inner bag is in contact with at least one of the magnets.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton in view of Koret (US 2,875,802). Regarding claim 2, Sutton does not

each the frame coupled to the outer sheath. Sutton as seen in Fig. 8, teaches a sheath with an inner bag 16 where the outer sheath is of the type that has a mouth frame but does not specifically teach the mouth frame. Koret teaches a similar outer sheath with a mouth frame. It would have been obvious to employ the frame of Koret in the outer sheath of Sutton to provide a means to hold open and secure the outer sheath mouth closed. The magnets are secured near the proximal portion of the frame. Regarding claim 3, the magnets will be secured on opposing sides of the frame since they are secured on opposing sides of the sheath.

Claims 1-4, 6-8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 4,872,401) in view of Crawley (US 2002/0025086 A1). Regarding claim 1, Lee as seen in teaches a container in which a soy or wine sauce is placed with an outer sheath 30 with a plurality of magnets within the outer sheath both near the proximal end and the distal end but does not teach the removable bag in the container. Crawley as seen in 1, teaches a bag for foodstuffs. It would have been obvious to employ the bag or liner of Crawley in the container of Lee to eliminate the need for cleaning the container as taught by Crawley. The structure of the modified container of Lee is capable of performing the claimed function of debris collection and the attraction of metallic debris that enters the removable bag. Lee does not specifically teach that the sheath 30 is made of a non-conductive material. However in the second embodiment Lee teaches that the box as seen in Fig. 2 is made of plastic. It would have been obvious to make the outer sheath 30 of plastic to provide an

inexpensive material for the sheath or provide a non-conductive material as taught by Lee in the second embodiment. Regarding claim 2, see Figs. 1 of Lee where the frame is 50. The open end of sheath encompasses the opening of the frame, the open end of the inner bag encompasses the opening of the frame as it is disposed inside of it and the one or more first magnets are coupled near the proximal portion of the frame. Regarding claim 3, the magnets, as seen in Fig. 1 are disposed on both sides of the opening and satisfies the claim limitation. Regarding claim 4, see Fig. 1, where 11 is a magnetically conductive material, i.e. metal. Regarding claim 6, there is no structure that is lacking from the combination of references to perform the claimed function. Regarding claim 7, Lee shows members 40 and 50 as being one-piece members in Figs. 1 but not does not teach making members 40 and 50 of plastic. It would have been obvious to make the members of plastic to provide an inexpensive way to form the complex one-piece structures. The process step of the injection molding does not add any structure that is not in the combination of references. Regarding claim 8, the magnet housing is formed between the outer sheath and the inner member 10. The magnets are disposed within the housing. Regarding claim 11, official notice is taken that it is well known to provide a container with a wider base than the top portion and to taper the sidewall between the two sizes or diameters. It would have been obvious to make the modified container of Lee more stable and less likely to tip over. Regarding claim 12, official notice is taken that it is well known to provide a container with a leather exterior. It would have

been obvious to make the exterior sheath of Lee leather to make a distinctive or more attractive appearance.

Claims 1, 2, 3, 6-8, 10, 11, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 4,872,401). Regarding claim 1, as seen in Figs. 2-4, teaches a container for holding cigarettes where the cigarettes are placed into the container within which the cigarettes are placed into the container with the cigarettes have some covering around them as seen in Fig. 3 but does not teach the covering is a bag or has an open proximal end. Official notice is taken that it is well known to contain cigarettes in soft pack of flexible wrappers. It would have been obvious to employ the soft flexible wrapper in the cigarettes of Lee to provide a simple and inexpensive package. Moreover, a hard pack is not required since they go in the case as seen in Fig. 3. It would have been obvious to open the pack to remove the cigarettes for use. The structure is capable of performing the claimed functions. Regarding claim 2, the frame is seen in Fig. 2 as item 62, when 62 is hinged on 60 the functional language of encompassing the openings is satisfied. The flexible package satisfies all the limitations of a bag. Regarding claim 3, see Fig. 4. Regarding claim 6, the magnets seen in Fig. 4 are capable of performing the claimed function. Regarding claim 7, the frame is made of plastic. The process step does not require any structure that is not in the reference. Regarding claim 8, see Figs. 2 and 4, where the magnet housings 63 and 63' are shown. Regarding claim 10, Lee does not teach the magnet housings being made of plastic. It would have been obvious to employ plastic in the magnet housings to provide an inexpensive housing for the

magnets. Regarding claim 12, Lee teaches that the outer sheath 60 is plastic but does not teach the case as seen in Figs. 2-4 of Leather. Official notice is taken that it is well known to provide leather cigarettes cases. It would have been obvious to make the outer sheath of or case of Lee of leather to provide for a durable and distinctive case. Regarding claim 13, it is inherent that the inner bag of Lee will contact some of the magnets shown in Fig. 4.

Response to Arguments

Applicant's arguments filed 5/24/04 have been fully considered but they are not persuasive. In response to applicant's arguments regarding the 102 b rejection with Alfero-Kuronya, it should have been rejected under 102 (e) since it clearly has an earlier filing date. The claims have been rejected 102(e).

Applicant further argues that element 30 is not a sheath. The examiner has carefully examined the specification and applicant has not defined the term sheath. Applicant specifically states on page 8, paragraph 36, that the sheath of the instant invention can be rigid or flexible. Since applicant has not defined the term then applicant is with the common or ordinary meaning of the word. The examiner has cited page 1078 of Merriam-Webster's Collegiate Dictionary as to what is the common or ordinary definition. None of these definitions appears to fit applicant's device. Definition 3 appears to be the only one to make sense in this situation. It states any of various covering or supporting structures that are applied like or resemble in appearance or function the sheath of a blade. It is

this definition that the examiner is relying on in the reference Alfero-Kuronya. Member 30 supports the inner bag in a manner that is similar to that of a blade. 30 is not the opening but the entire structure except the bag. This support structure is what is seen as the sheath for the inner bag 22. Inner bag 22 is suspended in a manner so that it is inside lower member 16, which is part of the support 30. Applicant is cautioned that if further arguments are provided that there is specific structure that is required to meet the term sheath that is not found in the prior art then the examiner will reject the claims under 112 first paragraph since the term has not been defined in the specification and is presenting arguments specific to the undefined term that are not found in the disclosure.

In response to applicant's arguments with respect to Yoshikawa does not disclose or suggest one or more second magnets disposed within an outer sheath. The examiner has carefully examined applicant's disclosure and there is not definition of the term "within". The examiner has cited page 1359 of the above referenced dictionary as to the common or usual definitions of the term within. A limiting definition of the term is found that supports applicant's position that they must be within the inside of the sheath which would lead one to believe that is has to be on an inner surface of the sheath. There is also a broader definition that supports the examiners position that the magnets be only disposed within the plastic of the sheath not necessarily on the inside surface of the sheath. Since applicant has limited the term with a specific definition then it is the examiners position that either is applicable and the rejection has been

maintained. Yoshikawa, as seen in Figs. 1 and 7, shows one or more first magnets (the ones near the open end) and one or more second magnets (near the bottom), which are disposed within the sheath. See Fig. 7 specifically where when the magnets are inside 4 are within the pockets 2 of the sheath they are enclosed or contained by the sheath. This clearly satisfies the broader definition of the term within seen on page 1359 of the above referenced dictionary.

Therefore the rejection has been maintained. These magnets are capable of performing the function of attracting debris that enter a removable bag. The magnets do not lack any structure that is not in the combination of references. The examiner suggests that applicant structurally define over the prior art rather than argue what is required to satisfy the term within since the term has not been defined in the specification. While claims terms are supposed to be interpreted in light of the specification, limitations from the specification are not read into the claims. The term within is a broad term and has been interpreted in a manner that is consistent with its definitions.

In response to applicant's argument that the intended use of containing debris as well as to attract metallic debris that enters a removable inner bag, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA

1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). All of the applied references are capable of performing the claimed function of containing debris and the attraction of the metallic debris. Applicant has not provided any evidence to the contrary.

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

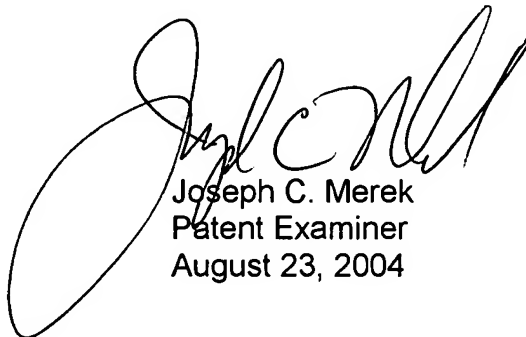
Conclusion

This action is a non-final action due to the new grounds of rejection as well as the change to a 102(e) on the Alfero-Kuronya reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Merek whose telephone number is (703) 305-0644. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph C. Merek
Patent Examiner
August 23, 2004